



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/478,051	01/15/2000	MICHAEL J. PICCIALLO	73348.00008	1136

29880 7590 12/05/2011

FOX ROTHSCHILD LLP  
PRINCETON PIKE CORPORATE CENTER  
997 LENOX DRIVE  
BLDG. #3  
LAWRENCEVILLE, NJ 08648

EXAMINER
----------

KUCAB, JAMIE R

ART UNIT	PAPER NUMBER
----------	--------------

3621

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

12/05/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@foxrothschild.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/478,051	<b>Applicant(s)</b> PICCIALLO, MICHAEL J.	
	<b>Examiner</b> Jamie Kucab	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 5) ☒ Claim(s) 75,78-83,85,87,99,111,112 and 114 is/are pending in the application.
- 5a) Of the above claim(s) 99,111 and 112 is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 75,78-83,85,87 and 114 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Acknowledgements***

1. Applicant's response filed November 16, 2011 is acknowledged.
2. Claims 75, 78-83, 85, 87, 99, 111, 112, and 114 are pending in the application.
3. Claims 99, 111, and 112 are withdrawn from consideration.
4. Claims 75, 78-83, 85, 87, and 114 are examined below.

### ***Priority***

5. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. §119(e) or under 35 U.S.C. §§ 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. §120 as follows:

6. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. §112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).
7. The disclosure of the prior-filed application, Application No. 08/585,173, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. 08/585,173 fails to provide

Art Unit: 3621

the necessary support for such limitations as “computer-based,” “establishing computer transfers of allowance money,” and “said transfers to occur periodically and automatically under computer processor control” of the independent claim 75.

***Claim Rejections - 35 USC § 112, First Paragraph***

8. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 79 and 87 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

10. Regarding claim 87, this claim is directed to a genus without sufficient written description.

11. “[G]eneric language in the application as filed does not automatically satisfy the written description requirement.” *Ariad Pharmaceuticals Inc. v. Eli Lilly & Co.*, 94 USPQ2d 1161, 1172 (Fed. Cir. 2010). “[A] sufficient description of a genus ... requires the disclosure of either a representative number of species falling within the scope of the genus or structural features common to the members of the genus so that one of skill in the art can ‘visualize or recognize’ the members of the genus.” *Id.* at 1171.

Art Unit: 3621

12. The limitation “prohibiting ... spending on alcohol or tobacco” functionally defines the boundaries of a genus. This genus is all of the algorithms that achieve the desired result of “prohibiting ... spending on alcohol or tobacco.” In the instant application, the disclosure provides some information, such as that it could be implemented using existing merchant category codes (“The account holder may also limit the amount of debit card transactions for specific classes of goods and services. Banking and credit card institutions have already encoded merchants and service providers with this information for billing purposes, so that it would not be difficult to similarly encode an approval request in a debit card point-of-sale transaction.”). However, because there is no merchant category code specific to purveyors of alcohol or tobacco, this fails to disclose an algorithm for achieving the desired result of prohibiting the sale of such goods. Therefore, no species (algorithm) has been disclosed to demonstrate possession of the genus (all possible algorithms for performing the recited function). Further, there is no discussion in the specification of structural features common to the members of the genus of possible algorithms to achieve the result of prohibiting spending on alcohol or tobacco. Therefore, the specification does not demonstrate possession by describing structural features common to members of the genus. Because there are neither species nor common features of the genus disclosed, the specification could not convey to one skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. Therefore, claim 87 is rejected as failing to comply with the written description requirement.

Art Unit: 3621

13. Claim 79 contains language similar to claim 87 as discussed in the preceding paragraphs (“wherein said goods or services comprise ... entertainment”), and for reasons similar to those discussed above, claim 79 is also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

***Claim Rejections - 35 USC § 112, Second Paragraph***

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 78, 79, 87, and 114 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

16. Regarding claim 78, Applicant’s recitation “a cash withdrawal or fund transfer initiated by said third party account” would have been unclear to a person having ordinary skill in the art at the time of the invention. It is unclear how a third party account can initiate a cash withdrawal or fund transfer.

17. Further regarding claim 78, Applicant’s recitation “verifying a cash withdrawal ... to determine whether the goods or services to be purchased are authorized” would have been unclear to a person having ordinary skill in the art at the time of the invention. It is unclear how the method can limit the spending of cash or predict how cash will be spent.

18. The Examiner finds that because particular claims are rejected as being indefinite under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, it is impossible to properly construe

Art Unit: 3621

claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP § 2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

### ***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claim 75 is rejected under 35 U.S.C. 102(e) as being anticipated by Fleming et al. (US Patent 5,953,710, hereafter, “Fleming”).

21. Regarding claim 75, Fleming discloses a computer-based method comprising:

a. creating a third party account (“a child’s credit card account,” Abstract) using information received from a fund depositor (“linked to a parent’s credit or debit card account,” Abstract);

- b. establishing computer transfers of allowance money into said third party account from said fund depositor account, said transfers to occur periodically and automatically under computer processor control ("When the parent selected allowances, they would be prompted by the Bank Telecom Interface 62 to enter the allowance amount and the periodic interval of the allowance, such as weekly." C14 L55-58); and
- c. supplying to said fund depositor information on payees ("Merchant/Info," Fig. 2A) and corresponding payment amounts ("Amount," Fig. 2A) for said third party account (see Fig. 2A showing that child transactions are a subset of the data provided on the Parent Statement List 56).

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claim 75 is alternately rejected under 35 U.S.C. 103(a) as being unpatentable over Gray (Ref. V on the PTO form 892 mailed June 8, 2005) in view of Examiner's Official Notice.

24. Regarding claim 75, Gray discloses a computer-based method comprising:
- d. creating a third party account using information received ("The accounts are set up," pg. 1);

Art Unit: 3621

- e. establishing computer transfers of allowance money into said third party account from said fund depositor account, said transfers to occur periodically and automatically under computer processor control ("The accounts are set up to allow automatic deposit" pg. 1); and
- f. supplying information on payees and corresponding payment amounts for said third party account ("bank statement," pg. 1).

25. Gray fails to explicitly disclose that the account is created using information received from the fund depositor (ie, parent) and that the information on payees and payment amounts is supplied to that fund depositor.

26. However, the Examiner takes Official Notice that it is old and well known in the art that parents do things for their children and read their correspondence because a parent often has incentives for doing so and it is often societally acceptable for a parent to do so.

27. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Gray to include the parental involvement of Examiner's Official Notice because all the claimed steps were known in the prior art and one skilled in the art could have combined the steps as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

28. Claims 78-83, 85, 87, and 114 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Fleming or Gray/Official Notice in view of Langhans et al. (US Patent 5,500,513, hereafter "Langhans").

Art Unit: 3621

29. Regarding claims 78-81, 87, 102-105, and 110, Fleming discloses as above, however, Fleming fails to explicitly disclose the steps of:

- a. limiting the amount of funds in said third party account that may be spent using said magnetic card on particular classes of goods and services using information entered by said fund depositor with a personal computer;
- b. verifying a fund transfer requested by said third party recipient using said magnetic card to determine whether said funds requested exceed the limit set for the goods or services to be purchased;
- c. wherein said goods or services comprise books, computer software, food, lodging or entertainment;
- d. wherein said limit is a periodic limit; and
- e. wherein said step of limiting the classes of goods and services on which funds in a third party account may be spent comprises prohibiting the withdrawal of cash or spending on alcohol or tobacco.

30. However, Langhans teaches:

- a. limiting the amount of funds in said third party account that may be spent using said magnetic card on particular classes of goods and services using information entered by said fund depositor with a personal computer ("The present invention also allows a company to group merchant category codes in order to limit purchases to those merchant types which would be needed by a particular department or individual." C2 L37-40);

Art Unit: 3621

- b. verifying a fund transfer requested by said third party recipient using said magnetic card to determine whether said funds requested exceed the limit set for the goods or services to be purchased ("A test 126 determines whether the Standard Industrial Classification (SIC) code of the merchant is acceptable for the account. If it is not, the request will be declined." C7 L55-58);
  - c. wherein said goods or services comprise books, computer software, food, lodging or entertainment ("a salesperson could be allowed a velocity checking limit for the category of hotels at a high frequency level, while an accounting clerk with no reason to travel could be allocated a lower velocity level, or allocated no authorization for hotels at all." C2 L12-17);
  - d. wherein said limit is a periodic limit ("Test 138 allows a spending limit to be applied over a company-defined cycle, such as a monthly cycle or other billing cycle." C8 L9-11); and
  - e. wherein said step of limiting the classes of goods and services on which funds in a third party account may be spent comprises prohibiting the withdrawal of cash or spending on alcohol or tobacco ("control cash advances," C13 L27-28).
31. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the method of Fleming to include the limiting step, verifying step, merchant categories, periodic limit, and controlling cash advances of Langhans in order to achieve the predictable result of giving the parent greater flexibility in the control of the child's spending.

Art Unit: 3621

32. Regarding claim 82, Fleming further discloses wherein said stored information on payees and corresponding payment amounts for said third party account is automatically supplied to said fund depositor ("Fig. 2a depicts a parent statement list 56 which is used to generate a monthly statement for the parent's credit card." C7 L25-26).

33. Regarding claim 83, Fleming further discloses wherein said supplying step is performed periodically ("Fig. 2a depicts a parent statement list 56 which is used to generate a monthly statement for the parent's credit card." C7 L25-26).

34. Regarding claim 85, Fleming further discloses wherein said money is transferred weekly or monthly ("When the parent selected allowances, they would be prompted by the Bank Telecom Interface 62 to enter the allowance amount and the periodic interval of the allowance, such as weekly," C14 L55-58).

35. Regarding claims 79 and 114, the combination Fleming/Langhans or Gray/O.N./Langhans teaches permitting purchases from a computer software store or a bookstore in that neither reference discloses preventing such purchases.

### ***Double Patenting***

36. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

Art Unit: 3621

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

37. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

38. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

39. Claims 75, 78-83, 85, 87, and 114 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 7,653,595 (application no. 11/549,065, filed October 12, 2006). Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ merely in terminology. Those limitations not explicitly disclosed in the claims of the '595 patent would be obvious in view of the claims of the '595 patent and either Langhans or Fleming.

***Response to Arguments***

40. Applicant's arguments filed June 29, 2011 have been fully considered, but they are only partially persuasive.

41. The claim objections and §101 and §112, 2<sup>nd</sup> paragraph rejections of the previous Office action have been withdrawn in response to Applicant's amendments.

42. Regarding the previous §103 rejections of the claims, Applicant argues that Fleming is not prior art, because the CIP ancestor Application 08/585,173 antedates Fletcher's filing date. Remarks, pgs. 5-11. The Examiner must respectfully disagree. The '173 application lacks any mention of a computer, and, therefore, lacks support for the limitation that the method is "computer-based" and the steps of "establishing computer transfers of allowance money" and "said transfers to occur periodically and automatically under computer processor control". The '173 application outlines an idea for a business arrangement with a credit card company. It is bereft of any details of the technological implementation of that idea. The declaration of Dr. David Lucantoni filed June 29, 2011 has also been considered but it is not persuasive. For these reasons, the denial of priority to the '173 application is maintained. The Fleming reference is still prior art relative to the instant application.

43. In response to applicant's arguments against Langhans individually (pg. 11), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

Art Unit: 3621

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

44. For the above reasons, the prior art rejections of the previous Office action are maintained as modified above in response to Applicant's amendments.

45. Regarding the double patenting rejections, Applicant again references a terminal disclaimer being filed in conjunction with the response (Remarks, pg. 12; previously in the Remarks filed October 27, 2010, pg. 14), however, no terminal disclaimer could be found in the file wrapper as of November 28, 2011. The double patenting rejections will be withdrawn when an appropriate terminal disclaimer is filed and approved.

### ***Conclusion***

46. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

47. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

48. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3621

49. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jamie Kucab/  
Primary Examiner, Art Unit 3621